



Attorney's Docket No.: 14219-065US1
Client's Ref.: P2002,0134USN

2834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Steffen Riemer Art Unit : 2834
Serial No. : 10/505,185 Examiner : Thomas M. Dougherty
Filed : September 29, 2004
Title : PIEZO ACTUATOR COMPRISING A STRUCTURE EXTERNAL
ELECTRODE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT OF JULY 10, 2006

In response to the outstanding restriction requirement in this application, Applicant hereby elects the claims of Group I, namely claims 1 to 13 and 18 to 25. This election is made with traverse for at least the following reasons.

This application is a PCT national stage application. Accordingly, pursuant to MPEP §1850, the USPTO is required to follow PCT rules regarding unity of invention. In particular, the MPEP states:

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT. (emphasis added)

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

August 1, 2006

Date of Deposit

Allem
S. 1

Denise M Donahue

Typed or Printed Name of Person Signing Certificate

Thus, to reiterate, U.S. restriction rules do not apply to this case. PCT rules apply.

Applicant submits that there is unity of invention for this application under PCT Rules 13.1 and 13.2. In this regard, PCT Rule 13.2 states

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In this regard, there is a relationship among the inventions of Groups I and II, which involve one or more of the same or corresponding special technical features. As stated in the rule, a special technical feature means "technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art".

In this case, the independent claims of both Groups I and II recite an external electrode on a face of a base, where the external electrode contacts at least some internal electrodes, and where the external electrode comprises a layer that has at least one local minimum. This is a special technical feature that is believed to define a contribution over the art. Both the claims in Group I and in Group II recite this special technical feature. Therefore, there is unity of invention under PCT Rules 13.1 and 13.2. Whether or not the claims of Groups I and II are process and product claims, and whether or not the claims are classified in different search categories, is not relevant to the analysis under PCT Rules 13.1 and 13.2. In this regard, Applicant notes that the international search report for the corresponding PCT application found there to be unity of invention.

Applicant : Steffen Riemer
Serial No. : 10/505,185
Filed : September 29, 2004
Page : 3

Attorney's Docket No.: 14219-065US1
Client's Ref.: P2002,0134USN

For at least the foregoing reasons, Applicant submits that the restriction is improper and should be withdrawn.

Finally, Applicant is submitting herewith a copy of the originally-signed Declaration to substitute for the Declaration currently on file in this case. In the Declaration currently on file, the U.S. serial number and filing date were added post signing (at the time they were added to the Assignment).

Applicant's attorney can be reached at the address shown above. All correspondence should continue be directed to Paul A. Pysher at the same address.

Please apply any fees associated with this response to Deposit Account 06-1050 referencing 14219-065US1.

Respectfully submitted,

Date: August 1, 2006



Paul A. Pysher
Reg. No. 40,780

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906



Attorney's Docket No.: 14219-065US1
 Client's Ref. No.: P2002,0134 US N

COMBINED DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled PIEZOE ACTUATOR COMPRISING A STRUCTURED EXTERNAL ELECTRODE, the specification of which:

[] is attached hereto.
 [] was filed on _____ as Application Serial No. _____
 [] was described and claimed in PCT International Application No. _____ filed on _____
 _____ and as amended under PCT Article 19 on _____

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose all information I know to be material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

Country	Application No.	Filing Date	Priority Claimed
WIPO	PCT/DE03/00141	January 20, 2003	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
Germany	10207530.1	February 22, 2002	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No

I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Paul A. Pysher, Reg. No. 40,780
 Frank R. Occhiuti, Reg. No. 35,306
 Denis G. Maloney, Reg. No. 29,670

Alan D. Smith, Reg. No. 32,002
 Mandy Jubang, Reg. No. 45,884
 Timothy A. French, Reg. No. 30,175

Direct all telephone calls to PAUL A. PYSHER at telephone number (617) 542-5070.

Direct all correspondence to the following:

26161
 PTO Customer Number

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

